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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,949	10/23/2000	Paul Price	0942.4120005/RWE/BJD	5489

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EXAMINER

COE, SUSAN D

ART UNIT	PAPER NUMBER
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1654

23

DATE MAILED: 08/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/693,949

**Applicant(s)**

PRICE ET AL.

**Examiner**

Susan Coe

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13, 18-21, 26, 29-32 and 34-40 is/are pending in the application.

4a) Of the above claim(s) 39 and 40 is/are withdrawn from consideration.

- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

- 6) ☒ Claim(s) 1-13, 18-21, 26, 29-32 and 34-38 is/are rejected.

- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 22. 6) ☐ Other:

### DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 30, 2003 has been entered.
2. Claims 1-13, 18-21, 26, 29-32, and 34-40 are pending.
3. In Paper No. 7, dated September 17, 2001, applicant elected without traverse lipoic acid for species A, myristate for species B, stigmastanol for species C, mammalian cells for species D, and potato for species E. Stigmastanol is not a known potato sterol or known to be used in cell culture media. Therefore, another species, stigmasterol, was selected for examination.
4. Claims 39 and 40 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 7. These claims are not considered to read on the elected species because they require two lipids or fatty acids while only one fatty acid (myristate) was elected.
5. Claims 1-13, 18-21, 26, 29-32, and 34-38 are examined on the merits.

### *Double Patenting*

6. Claims 1-13, 18-21, 26, 29-32, and 34-38 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over all of the claims of U.S. Patent No. 6,103,529 for the reasons set forth in the previous Office action.

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The examiner acknowledges applicant's intent to file a terminal disclaimer on the indication of allowable subject matter. However, until the terminal disclaimer is filed, this rejection is still considered valid.

***Claim Rejections - 35 USC § 102***

7. Claims 1, 2, 12, 13, 26, and 34-38 are rejected under 35 U.S.C. 102(b) as being anticipated by DIFCO manual (1984) in light of Dyas et al. (Phytochemistry (1994), vol. 35, no. 3, pp. 655-660) for the reasons set forth in the previous Office action.

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant argues that the DIFCO manual does not anticipate the stated claims because the use of the claimed culture media for the cultivation of animal cells is not simply a recitation of intended use because there are additional ingredients that are needed to cultivate animal cells that are not present in the media taught by DIFCO. Therefore, there is a structural difference between the DIFCO media and the media claimed by applicant. For support of this argument, applicant references pages 11-19 of the specification. In reading this portion of the specification, applicant's have described a media that has ingredients that would be contained in the media taught by the DIFCO manual. The ingredients used to make potato agar in the reference would contain amino acids, vitamins, trace element, etc. because these items are naturally present in potatoes and agar. Therefore, it still appears that the culture media taught by DIFCO anticipates the stated claims because it would contain the ingredients that applicant has indicated are needed to cultivate animal cells.

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***Claim Rejections - 35 USC § 103***

8. Claims 1-5, 8-13, 26, 29-32, and 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over DIFCO manual (1984) in light of Dyas et al. (Phytochemistry (1994), vol. 35, no. 3, pp. 655-660) in view of Gibco BRL Life Technologies, Gaithersburg, MD, 1993-1994 Catalogue and Reference Guide pp. 1-105 through 1-107, 1-115 through 1-116, 1-123, 4-49, 4-50, 4-61, and 4-63 for the reasons set forth in the previous Office action.

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant argues that there is not sufficient motivation from the references to combine the teachings of the references to arrive at the claimed invention. However, it has been established legally that combining ingredients together that are known to be used for the same purpose is considered to be obvious (see *In re Pinten*, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); *In re Susi*, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); *In re Crockett*, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960); *In re Sussman*, 1943 C.D. 518; *In re Huellmantel* 139 USPQ 496; *In re Crockett* 126 USPQ 186). The references show that it was known in the art at the time of the invention that all of applicant's claimed ingredients are used for the same purpose. Therefore, it is considered to be an obvious modification of what was known in the art at the time of the invention to combine the teachings of the references.

9. Claims 1-13, 18-21, 26, 29-32, and 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5,122,469 in view of Dyas et al. (Phytochemistry (1994), vol. 35, no. 3, pp. 655-660) and Gibco BRL Life Technologies, Gaithersburg, MD, 1993-1994 Catalogue

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and Reference Guide pp. 1-105 through 1-107, 1-115 through 1-116, 1-123, 4-49, 4-50, 4-61, and 4-63 for the reasons set forth in the previous Office action.

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant argues that the fact that US '469 does not specifically teach deriving the lipids and peptides from potato creates a patentable difference between the claimed media and the media taught by the reference because the biological characteristics of the peptides and lipids would vary based on the source of peptide and lipids. However, applicant's limitation of potatoes as the source of the peptides and lipids is considered to be a product-by-process limitation. Note that MPEP § 2113 states that:

"[w]hen the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 35 U.S.C. 102 or 35 U.S.C. 103 of the statute is appropriate. As a practical matter, the Patent and Trademark Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith. A lesser burden of proof is required to make out a case of prima facie obviousness for product-by-process claims because of their peculiar nature than when a product is claimed in the conventional fashion. In re Brown, 59 CCPA 1063, 173 USPQ 685 (1972) ; In re Fessmann, 180 USPQ 324 (CCPA1974)."

Therefore, with these types of claims, the burden falls on the applicant to establish a difference between the claimed invention and the prior art. Both the claimed media and the prior art media contain the same ingredients and are capable of supporting the cultivation of animal cells.

Applicant has offered no evidence that the source of the ingredients creates a difference between the two media. Therefore, no patentable difference has been established between the claimed invention and the prior art.

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Applicant also argues that there is not sufficient motivation from the reference to combine the teachings of the references to arrive at the claimed invention. However, it has been established legally that combining ingredients together that are known to be used for the same purpose is considered to be obvious (see *In re Pinten*, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); *In re Susi*, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); *In re Crockett*, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960); *In re Sussman*, 1943 C.D. 518; *In re Huellmantel* 139 USPQ 496; *In re Crockett* 126 USPQ 186). The references show that it was known in the art at the time of the invention that all of applicant's claimed ingredients are used for the same purpose. Therefore, it is considered to be an obvious modification of what was known in the art at the time of the invention to combine the teachings of the references.

10. No claims are allowed.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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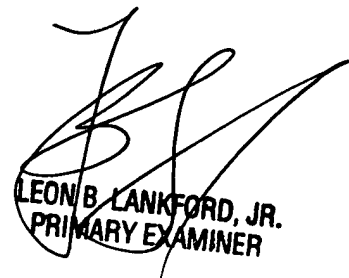
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe whose telephone number is (703) 306-5823. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30 and on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached on (703) 306-3220. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Susan Coe, Examiner  
August 20, 2003



LEON B. LANKFORD, JR.  
PRIMARY EXAMINER